

**REMARKS**

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 1-32 were pending prior to the Office Action. In this Reply, claims 33-35 are added. Therefore, claims 1-35 are pending. Claims 1, 10, 16, 20 and 29 are independent.

**SCOPE NOT CHANGED**

Claim 16 is amended merely for clarification purposes. It is intended that the scope is not narrowed.

**§ 103 REJECTION – FUKUNAGA, HIRAI**

Claims 1-4, 7, 9-13, 15-18, 20-25 and 29 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Fukunaga et al. (U.S. Patent 6,775,023) in view Hirai (U.S. Patent 6,493,108). *See Office Action, pages 2-6.* Applicants respectfully traverse.

Independent claim 1 recites in part, “when the recording medium, storing a digital image data, a server-connection address information, and a designated print-order acceptor information, is mounted to the terminal unit, said terminal unit is connected to set order receiving server based on said server-connection address information so as to transmit said designated print-order

acceptor information and at least a part of said digital image data at the same time to set order receiving server.” In other words, the digital image data as well as the server-connection address information and the designated print-order acceptor information are recorded on the recording medium and transmitted by the terminal unit.

Contrary to the Examiner’s allegation, Fukunaga cannot teach or suggest at least this feature. Fukunaga is directed towards a print system in a network that responds to a print request from a client. *See column 1, lines 9-13.* Fukunaga discloses that the system includes a client computer 101, a center server 102, a plurality of image servers 111-11N, and a plurality of print servers 121-12N. *See Fukunaga, Fig. 1.* Fukunaga discloses that all images are stored either in the center server 102 (see column 5, lines 60-61), image servers 111-11N (see column 6, lines 1-3), and the print servers 121-12N (see column 6, lines 7-12). Fukunaga is entirely silent regarding whether the client computer (allegedly equivalent to the terminal unit as recited) mounts a recording medium that includes image data.

Indeed, the suggestion is quite the opposite. Fig. 8 of Fukunaga illustrates a structure of the print-order data that is maintained within the center server 102. Each print-order 801 includes one or more sub-orders 802 which in turn include one or more order-items 803 and image ID 805. *See Fig 8; column 13, line 56-column 14, line 28.* As illustrated in Figs. 9A and 9B, the

image ID 805 clearly identifies the location of the original image to be printed. The original image location is identified by the name of the server, identification of the server that registered the original image ID (i.e. has the original image), and the identification of the image within the server itself. *See Figs. 9A-9B; column 14, line 34-column 15, line 8.* In other words, the print request merely identifies the location of the server in which the image data is stored.

Thus, contrary to the Examiner allegation, Fukunaga cannot teach or suggest the feature of the recording medium that stores the digital image data as recited in claim 1. Further, Fukunaga cannot teach or suggest the feature of the terminal unit transmitting the designated print-order acceptor information and at least a part of said digital image data at the same time to set order receiving server. Hirai is not relied upon to correct for these deficiencies of Fukunaga. This alone is sufficient to distinguish claim 1 over the combination of Fukunaga and Hirai.

But in addition, the combination of Fukunaga and Hirai is improper since Fukunaga teaches away from the claimed invention. Fukunaga recognizes that an image may be transmitted from the client computer to the center server. However, Fukunaga describes this as a problem since the access time to the network increases and the communication cost rises. *See column 1, lines 50-60.* Fukunaga discloses that by managing the locations where the

image data are stored - in image servers and print servers - cost can be minimized. *See column 2, lines 58-65.*

Since Fukunaga plainly indicates that transmitting image data from the client to the center server to fulfill a print request is undesirable, Fukunaga teaches away from the feature as recited in claim 1. Then by definition, there is no motivation to combine Fukunaga with Hirai and the combination is improper.

Further, if Fukunaga is modified as suggested by the Examiner, Fukunaga will be unsatisfactory for its intended purpose since the access time to the network and the communication costs will both rise.

Yet further, Hirai cannot teach or suggest a recording medium that includes the image data, the server-connection address information and the designated print-order acceptor information as the Examiner alleges. The Examiner alleges that the recording medium 1 as illustrates in Fig. 1 of Hirai is equivalent to the recording medium as recited. Hirai discloses that the recording medium includes the image-reproduction instruction data 4. *See Hirai, Fig. 1.* Fig. 3 of Hirai illustrates the structure of the image-reproduction instruction data 4. As shown, the structure merely includes an identification of the image to be printed and the number of prints for the identified image. Hirai is completely silent regarding whether the image reproduction instruction data 4 includes the server connection or the print-order acceptor information.

Indeed the suggestion is quite the opposite. A simple observation of Hirai indicates that the system as illustrated in Fig. 1 is a stand alone print-order acceptor apparatus. The print-order form generating unit 2 accepts the recording medium, processes the order request and directly sends the result to the output unit 3. A stand alone unit would have no need to identify a server of any type.

For at least the above stated reasons, claim 1 is distinguishable over the combination of Fukunaga and Hirai. Independent claim 10 recites, in part “ a recording medium on which digital image data has been recorded, ... and which stores therein connection address data to an order receiving server connected to said network, designated print-order acceptor information.” It is demonstrated above that neither Fukunaga nor Hirai teaches or suggest at least this feature. Thus, the combination also fails to teach or suggest this feature. In addition, it is demonstrated that the combination of Fukunaga and Hirai is not valid. For at least the above stated reasons, claim 10 is distinguishable over the combination of Fukunaga and Hirai.

Independent claim 16 recites, in part “a recording medium on which digital image data have been recorded” and “recording on said recording medium connection address data to a print-order receiving server connected to a network, designated print-order acceptor information, and data for causing said terminal unit to connect to said order receiving server.” It is demonstrated

above that the combination of Fukunaga and Hira cannot teach or suggest these features and that the combination is improper. For at least these reasons, claim 16 is distinguishable over the combination of Fukunaga and Hirai.

Independent claim 20 recites, in part “information stored within the recording medium includes connection address data of a selected print server receiving server among the one or more print server receiving servers, requested server shop data, and image data.” Independent claim 29 recites, in part “wherein the information stored in the recording medium include connection address data of the print server receiving server, server shop data of the requested server shop, and the image data.” As demonstrated above, the combination of Fukunaga and Hira cannot teach or suggest these features. Also the combination is improper. For at least these reasons, claims 20 and 29 are distinguishable over the combination of Fukunaga and Hirai.

Claims 2-4, 7, 9, 12-13, 15, 17-18 and 25 depend from independent claims 1, 10, 16 and 20 directly or indirectly. Then for at least due to the dependencies thereon, these dependent claims are also distinguishable over the combination of Fukunaga and Hirai.

Applicants respectfully request that the rejection of claims 1-4, 7, 9-13, 15-18, 20, 25 and 29 based on Fukunaga and Hirai be withdrawn.

§ 103 REJECTION – FUKUNAGA, HIRAI, FANNING

Claims 5-7, 9, 23-24 and 31-32 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Fukunaga and Hirai and in further view of Fanning et al. (U.S. Patent 6,742,023). *See Office Action, pages 6-8.* Applicants respectfully traverse.

It is noted that the rejected claims depend from independent claims 1, 20 and 29 directly or indirectly, and it is demonstrated above that claims 1, 20 and 29 are distinguishable over the combination of Fukunaga and Hirai. Fanning is not relied upon to correct for at least the above noted deficiencies of Fukunaga and Hirai. Indeed, any combination that includes Fukunaga is improper. For at least the above stated reasons, independent claims 1, 20 and 29 are distinguishable over the combination of Fukunaga, Hirai and Fanning.

Then for at least due to the dependencies thereon, claims 5-7, 9, 23-24 and 31-32 are also distinguishable over the combination of Fukunaga, Hirai, and Fanning. Applicants respectfully request that the rejection of these claims based on Fukunaga, Hirai and Fanning be withdrawn.

§ 103 REJECTION – FUKUNAGA, HIRAI, FREDLUND

Claims 8, 14 and 19 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Fukunaga and Hirai, and in further view of Fredlund

et al. (U.S. Patent 5,666,215). *See Office Action, page 8.* Applicants respectfully traverse.

These rejected claims depend from independent claims 1 and 16 directly or indirectly, and it is demonstrated above that claims 1 and 16 are distinguishable over Fukunaga and Hirai. Fredlund is not relied upon to correct for at least the above noted deficiencies of Fukunaga and Hirai. Also, the combination is improper since it includes Fukunaga. For at least the above stated reasons, independent claims 1 and 16 are distinguishable over the combination of Fukunaga, Hirai and Fredlund.

Then for at least due to the dependency thereon, claims 8, 14 and 19 are also distinguishable over the combination of Fukunaga, Hirai and Fredlund. Applicants respectfully request that the rejection of claims 8, 14 and 19 based on Fukunaga, Hirai and Fredlund be withdrawn.

§ 103 REJECTION – FUKUNAGA, HIRAI, FANNING, FREDLUND

Claim 8 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Fukunaga, Hirai and Fanning and in further view of Fredlund. *See Office Action, pages 8-9.* Applicants respectfully traverse.

It is demonstrated above that claim 8 is distinguishable over the combination of Fukunaga, Hirai and Fredlund. Fanning is not relied upon to correct for the above noted deficiencies of Fukunaga, Hirai and Fredlund.



Therefore, claim 8 is also distinguishable over the combination of Fukunaga, Hirai, Fanning and Fredlund.

Applicants respectfully request that the rejection of claim 8 based on Fukunaga, Hirai, Fanning and Fredlund be withdrawn.

§ 103 REJECTION – FUKUNAGA, HIRAI, SUBRAMANIAM

Claims 21-22 and 30 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Fukunaga and Hirai and in further view of Subramaniam et al. (U.S. Patent 6,081,900). *See Office Action, pages 9-10.* Applicants respectfully traverse.

Claims 21-22 and 30 depend from independent claims 20 and 29 directly or indirectly and it is demonstrated above that claims 20 and 29 are distinguishable over the combination of Fukunaga and Hirai. Subramaniam is not relied upon to correct for at least the above noted deficiencies of Fukunaga and Hirai. Therefore, claims 20 and 29 are distinguishable over the combination of Fukunaga, Hirai and Subramaniam.

Then for at least due to the dependency thereon, claims 21-22 and 30 are also distinguishable over the combination of Fukunaga, Hirai and Subramaniam. Applicants respectfully request that the rejections of claims 21-22 and 30 based on Fukunaga, Hirai and Subramaniam be withdrawn.

§ 103 REJECTION – FUKUNAGA, HIRAI, HURTADO

Claims 26-28 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Fukunaga and Hirai and in further view of Hurtado et al. (U.S. Patent 6,611,812). *See Office Action, pages 10-11.* Applicants respectfully traverse.

Claims 26-28 depend from independent claim 20 directly or indirectly, and it is demonstrated above that claim 20 is distinguishable over the combination of Fukunaga and Hirai. Hurtado is not relied upon to correct for at least the above noted deficiencies of Fukunaga and Hirai. Therefore, claim 20 is distinguishable over the combination of Fukunaga, Hirai and Hurtado.

Then for at least due to the dependency thereon, claims 26-28 are also distinguishable over the combination of Fukunaga, Hirai and Hurtado. Applicants respectfully request that the rejection of claims 26-28 based on Fukunaga, Hirai and Hurtado be withdrawn.

NEW CLAIMS

Claims 33-35 are added through this reply. It is respectfully submitted that the new claims are distinguishable over the cited references individually or in any combination for at least due to the dependency from independent claims 20 and 29. Applicants respectfully request that the new claims be allowed.

**CONCLUSION**

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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